

REMARKS

The Examiner's final Office Action dated January 27, 2004 has been received and its contents carefully noted. Applicant respectfully submits that this response is timely filed and fully responsive to the Office Action. By the above amendments, claims 1 and 37 have been amended and claims 2, 3, 5, 10, 11 and 22 have been canceled by the foregoing amendment. Consequently, claims 1, 4, 6-9, 12-14 and 20, 21 and 23-37 are currently pending of which claims 1 and 37 are independent. In light of the above amendments and detailed arguments to follow, reconsideration of the currently proposed rejection is respectfully requested.

Applicant notes the most recent Office Action has been made final. **Applicant respectfully requests withdrawal of the finality of the present Office Action.** The Office Action of July 7, 2003 did not present any rejection(s) of claim 37 which was originally presented in the Preliminary Amendment filed with the original application papers on June 13, 2000. As a result, in the Amendment filed October 8, 2003, Applicant placed claim 37 into independent form including the limitations of the base claim (original claim 1). In the final Office Action dated January 27, 2004, the Examiner indicated that the omission on the part of the Office was a typographical error. Applicant disagrees with this statement.

Applicant notes that the feature of claim 37 that "the label is at least partially provided with adhesive on at least one side" was not discussed in the Office Action of July 7, 2003. More specifically, the features of this claim were not duplicated in any other pending claim and were never discussed with regard to another claim. Accordingly, contrary to the assertion in the Final Office Action of January 29, 2004, Applicant submits there was no typographical error in the first Office Action. Further, even if, as the Examiner indicates, the error was the result of a typographical error, the error was not evident to the Applicant and thus the Applicant could not have known that such an error occurred. As such, the finality of the Official Action is still improper.

Moreover, MPEP 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c) with the fee set forth in 37 C.F.R. 1.17(p). (emphasis added)

In view of the improper finality of the January 27, 2004 Office Action, Applicant respectfully requests reconsideration of the finality of the Office Action since independent claim 37 is only once rejected and considered a new ground of rejection. If the Examiner is not convinced that the finality of the last Office Action was improper and withdraws the finality, Applicant requests that this paper also be treated as a Petition under 37 C.F.R. 1.181 requesting withdrawal of the Finality of the Previous Office Action.

Turning now to the rejections in the Office Action, claims 1, 10, 12-14 and 32 are under 35 U.S.C. 102(b), as being anticipated by Tiffany ('054), claims 11 and 20, are rejected under 35 U.S.C. 103(a), as being obvious in view of the teachings of Tiffany ('054); claims 2-7, 9, 20-25 and 33-37, are rejected under 35 U.S.C. 103(a), as being obvious in view of the teachings of Tiffany ('054) combined with the teachings of Saliga ('363) and Dlugos et al. ('842); claims 2, 7-9 and 33-36 are rejected under 35 U.S.C. 103(a), as being obvious in view of the teachings of Tiffany ('054) combined with the teachings of Watanabe et al. (991); and claims 26-32 are rejected under 35 U.S.C. 103(a), as being obvious in view of the teachings of Tiffany ('054) combined with the teachings of Piosenka et al ('903). Applicant respectfully traverses each of these rejections.

The presently claimed invention, as set forth in claim 1, requires at least one electronic component, a protective cover layer, wherein the protective cover layer further comprises a transparent synthetic material applied by flowing the synthetic material from a nozzle in a drip process formed over at least one surface of said at least one electronic component, and wherein the transparency of the synthetic material enables visual access to the at least one electronic component, a self adhesive layer formed on at least one side of said label, and a protective foil associated with the self adhesive layer. Support for the newly added features can be found, for example, in page 3, lines 9-17, page 8, line 4 and page 9 lines 2-5 of the specification.

In contrast to the invention of claim 1, the "smart card" of Tiffany comprises a top layer (Figure 2, element 24), a bottom layer (element 26) and core layer (element 28), in which the smart card electronic components (elements 30, 32) are completely embedded in the core layer, using an injection molding apparatus/process, such that the composite smart card is unusually thick and all surfaces of the electronic components are covered by the core layer material.

Applicant respectfully submits that the Tiffany patent fails to disclose or suggest a protective cover layer, wherein the protective cover layer further comprises a transparent synthetic material wherein the transparency of the synthetic material enables visual access to the at least one electronic component. Moreover, Applicant submits that Tiffany does not disclose or suggest a self adhesive layer formed on at least one side of said label; and a protective foil associated with the self adhesive layer as now set forth in independent claim 1.

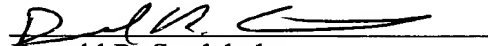
Such a structure is distinctly different from that presently claimed and, in contrast to claim 1, intentionally provides no visual access to the electronic components of the smart card without destroying the integrity of the smart card. Since each feature of the instant claim 1 is not taught by the Tiffany reference, the rejection under § 102(e) cannot be maintained and withdrawal is respectfully requested.

A review of each of the Dlugos (cited to show the use of adhesive to affix a pouch for a label to a surface), Saliga (cited to show the use of adhesive to affix a tag to a surface), Watanabe (cited to show tags with printing can be adhesively bound to an elongate protective strip), and Piosenka (cited to show that a smart card can be provided with an electronic display means but without any teaching of the actual smart card structure) reveals that none of these references overcomes the deficiency of Tiffany noted above. Specifically, none of Dlugos, Saliga, Watanabe or Piosenka disclose or suggest a transparent synthetic material wherein the transparency of the synthetic material enables visual access to the at least one electronic component.

Therefore, even if combined as asserted by the Examiner, the combination would not teach each feature of instant claim 1; nor would the combination provide any suggestion/motivation to one of ordinary skill in the prior art to modify the teachings of Tiffany to only partially encapsulate one surface of the smart card to achieve the structure of the label of claim 1. For these reasons the rejections under § 103(a) also cannot be maintained and withdrawal is respectfully requested.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



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